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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KOJI IDEI

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/508,617
Filing Date: March 14, 2000
Appellant(s): IDEI ET AL.

William L. Brooks
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 16, 2007, appealing from the Office action mailed November 22, 2006.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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4,279,961

FUJIOKA ET AL

7-1981

4,207,142

SHEPHERD

6-1980

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections – 35 USC § 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujioka et al. (U.S. 4,279,961).

Fujioka discloses a recording material with a base sheet (abstract) where a coating is applied to the base sheet comprising cationic resins, such as quaternary ammonium salts, having a surface resistivity of 10^6 to 10^{10} ohms and 2 to 20 g/m² by dry weight (column 5, lines 33-44) where the resistivity is higher in an atmosphere of lower humidity (column 1, lines 39-48). Fujioka further discloses coating a paper on both sides (column 8, lines 9-11).

In instant claim 1, the phrase “as measured by colloidal titration method” introduces a process limitation to the product claim. The patentability of a product does

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not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. Although *Fujioka* teaches the recording material can be used in copying machines and other printers (column 1, lines 9-19) the reference does not explicitly disclose it is used for ink jet and electrophotographic recording. In claim 1, the phrases, “for ink jet and electrophotographic recording” is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Because *Fujioka* discloses a paper comprising the same cationic resin (quaternary ammonium salt) and surface resistivity as instantly claimed, the cation equivalent is an inherent feature. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. The

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Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

Claim Rejections – 35 USC § 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. (U.S. 4,279,961) in view of Shepherd (U.S. 4,207,142).

Fujioka is relied upon for claim 1 as above. Although Fujioka does not explicitly teach making the paper from pulp, it would have been obvious for the paper to contain pulp because paper is conventionally made from pulp. Fujioka does not teach the paper having a neutral rosin sizing agent or alkenyl succinic anhydride as an internal sizing agent. Shepherd teaches paper sizing materials consisting of rosin (column 1, lines 18-20) and alkenyl succinic anhydride sizing agents (column 2, lines 45-63). It would have been obvious to one of ordinary skill in the art to include a rosin or alkenyl succinic anhydride sizing agent in the paper of Fujioka because Shepherd teaches the sizing

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agents impart to paper good resistance to acidic liquids and do not detract from the strength of the paper and can increase the strength of the finished sheets (column 13, lines 48-60).

(10) Response to Argument

Issue 1

Appellant argues that claims 1 and 3-7 are patentable over 35 U.S.C. 112, first paragraph. Appellant argues that page 15, lines 8-16 discloses the cationic resin is adhered to a support and page 18, line 22 to page 19, line 9 discloses a cationic resin is adhered to both sides of a synthetic paper. Examiner acknowledges Appellant's arguments and withdraws the rejection made under 35 U.S.C. 112, first paragraph, because the phrases, 'present on a *surface* of the support' and 'wherein the cationic resin is present on surfaces of both sides of the support' are supported by the instant specification.

Issue 2

Appellant argues that claims 1 and 3-7 are not patentable under 35 U.S.C. 102(b) as being anticipated by Fujioka et al. (U.S. 4,279,961). Examiner notes that claims 1 and 5-7 were rejected under 35 U.S.C. 102(b) as being anticipated by Fujioka et al. (U.S. 4,279,961). Claims 3-4 will be addressed in Issue 3. Appellant acknowledges that Fujioka comprises a paper substrate, electroconductive layer and

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record forming layer formed on the electroconductive layer, where a cationic resin is contained only in the electroconductive layer. Appellant further argues a cationic resin is not present on the surface of the recording layer.

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a cationic resin is not present on the surface of the recording layer) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Appellant claims a paper comprising a support having a cationic resin present on a surface of the support. Fujioka discloses a recording material with a base sheet (abstract) where a coating is applied to the base sheet comprising cationic resins (column 5, lines 33-44). Because, as Appellant acknowledges, an electroconductive layer comprising cationic resin is formed on the base sheet, it is reasonable to conclude that the cationic resin formed in the electroconductive layer is present on a surface of the base sheet. Appellant argues Fujioka fails to disclose or suggest that the surface resistivity of the recording side of the paper is 1.0×10^9 - $9.9 \times 10^{13} \Omega$, as claimed. Examiner maintains that Fujioka discloses a surface resistivity of 10^6 to $10^{10} \Omega$, for the coating composition, which is applied to the base sheet (column 5, lines 33-44), which meets the limitations of instant claims 1 and 5. Appellant argues the present claims permit the cationic resin to be present on both surfaces and Fujioka does not teach the cationic resin is present on either side of the paper. Fujioka discloses another electroconductive layer is formed on the other

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surface of the base sheet opposite the record layer, where the additional electroconductive layer is similarly formed (column 5, lines 45-49) as the first electroconductive layer. Because the first electroconductive layer comprises cationic resin, it is reasonable to expect the additional electroconductive layer, which is formed similarly as the first, to comprise cationic resin, which is formed on both sides of the base sheet.

Issue 3

Appellant argues that claims 1 and 3-7 are not patentable under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. (U.S. 4,279,961) in view of Shepherd (U.S. 4,207,142). Examiner notes that claims 3-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. (U.S. 4,279,961) in view of Shepherd (U.S. 4,207,142). Claims 1 and 5-7 were addressed in Issue 2.

In response to appellant's argument that Shepherd, like Fujioka fails to mention or suggest the cationic resin being present on a surface of the paper, which may include the recording side, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As Appellant stated, Shepherd has been cited for teaching paper sizing materials consisting of rosin and alkenyl succinic anhydride sizing agents.

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As argued in Issue 2, Fujioka teaches the cationic resin present on a surface of the paper (base sheet). Because Fujioka has been maintained over instant claim 1 and Appellant has presented no arguments regarding unpatentability of claims 3-4, with respect to Fujioka in view of Shepherd, claims 3-4 remain rejected by Fujioka in view of Shepherd for reasons of record.

Issue 4

Appellant argues that claims 1 and 3-7 are not patentable under 35 U.S.C. 102(b) as being anticipated by Asano et al. (U.S. 6,335,085). Examiner notes that claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Asano et al. (U.S. 6,335,085). Appellant argues that because the range of dry adhering amount of 0.5 to 2.0g/m² is narrower than the dry adhering amount in Asano et al, the surface resistivity limitation of claim 1 might not be met when the dry adhering amount is outside the range recited in claim 1, which renders the surface resistivity and cationic equivalent not inherently taught by Asano et al. Upon further consideration and in light of Appellant's arguments, the rejection made under Asano et al is withdrawn.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

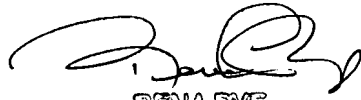
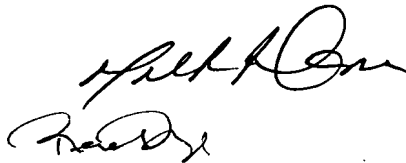
Respectfully submitted,

Lawrence Ferguson 

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Milton Cano

Rena Dye


RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1774